



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,033	12/20/2000	Ji Sun	100390-09922	9605

35745 7590 01/16/2004

KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
919 THIRD AVENUE
NEW YORK, NY 10022

EXAMINER

EPPERSON, JON D

ART UNIT	PAPER NUMBER
----------	--------------

1639

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/742,033

Applicant(s)

SUN ET AL.

Examiner

Jon D Epperson

Art Unit

1639

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 26 November 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: _____.

Claim(s) rejected: 3, 4, 9-20, 22 and 26-34.

Claim(s) withdrawn from consideration: 23-25.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

The After-Final amendment is denied entry for the following reasons:

1. Claims 3-4 and 14 (currently amended) inserts new claim limitations (e.g., claim 3 no longer requires that the coreactant “undergoes” oxidation or reduction, but only that it “can” undergo said oxidation or reduction; claim 14 is now also drawn to an “aliphatic” tertiary amine whereas it was drawn to Both “aliphatic” and “aromatic” before the amendment), which introduces the issue of new matter and/or additional search and consideration.
2. Applicants’ amendments do not place the application in condition for allowance.
3. There is no reason given for why the amendment was not earlier presented.
4. Finally, applicants added six new claims (i.e., 35-40) and only canceled four claims (i.e., claims 22 and 23-25). Therefore, applicants have presented additional claims without canceling a corresponding number of finally rejected claims.

The following comments are noted:

5. Applicants state that the finality of the rejection is improper and should be reversed (e.g., see 5/30/2003 response, pages 9-10). Specifically, Applicants relies on MPEP § 706.07(a) to support their position alleging that the scope of claim 9 has not changed and, as a result, the rejection was not necessitated by Applicants’ amendments.

Art Unit: 1639

6. The Examiner's position is that the scope of claim 9 has changed because it depends on claim 3 whose scope has been narrowed. Furthermore, the Examiner argues that even if *assuming arguendo* that the scope of claim 9 has not changed, the Finality would still be proper because the new reference(s) were found as a result of Applicants' amendments to their generic claim, which is in compliance with MPEP § 706.07(a).

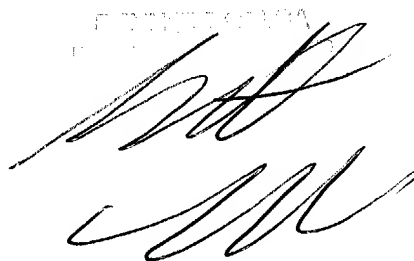
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (703) 308-2423. The examiner can normally be reached Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (703) 306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2439.

Jon D. Epperson, Ph.D.
January 13, 2003

A handwritten signature in black ink, appearing to be 'Jon D. Epperson', written over a faint, rectangular stamp that is mostly illegible.